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I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST-CLASS MAIL IN AN ENVELOPE ADDRESSED TO: ASSISTANT COMMISSIONER FOR PATENTS, WASHINGTON, D.C. 20231, ON OCTOBER 15, 2001

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AGENT/ATTORNEY FOR APPLICANT

October 15, 2001
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Docket No. 0803

#13/K.T. 2/22

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Habben, et al.	Date:	October 15, 2001
Serial No.:	09/545,334	Group Art Unit:	1635
Filed	April 7, 2000	Examiner:	M. Schmidt

Election

For: "Regulated Expression of Genes in Plant Seeds"

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

Please reconsider the Restriction Requirement mailed August 14, 2001, in light of the remarks below. Said Restriction Requirement states as follows:

> "This application contains claims directed to the following patentably distinct species of the claimed invention: (1) any cytokinin modulating gene and (2) any species of plant. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for each of (1) and (2) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, all claims are generic."

TRAVERSAL OF RESTRICTION REQUIREMENT

Applicants respectfully traverse the Restriction Requirement for the reasons below.

As stated in MPEP 806.04(e), species are *usually* but not always independent as disclosed. (underscore added) Disclosure of commonality of operation, function, or effect must be considered in determining the independence of the embodiments.

The Examiner's attention is drawn to page 4, lines 14-28. There it is clear that the invention provides "several useful genetic constructs and methods to modulate effective levels of cytokinin in plant seeds, developing plant seeds, and related maternal tissues." Thus, these several constructs and methods, and products of the methods, share commonality of operation, function, and effect. In fact, the last sentence states, "A combination of both approaches [anabolic and catabolic] is also contemplated by this invention." This implies use of *more than one* cytokinin-modulating gene to achieve the claimed effect. Further support for this commonality is provided, for example, at page 7, where a definition is provided for any "cytokinin metabolic enzyme-binding molecule." See also page 15, line 32, through page 16, line 7, including this statement: "Accordingly, any structural gene, the regulated expression of which has the effect of enhancing the effective levels of cytokinin in plants, particularly seeds, is useful for the practice of this invention." Thus, commonality of operation, function, or effect among the embodiments is disclosed, and restriction to a single cytokinin modulating gene is improper.

As to restriction to a single species of plant, the Applicants respectfully direct the Examiner's attention to page 32, lines 21-31, where a multitude of plant genera are disclosed. As stated therein (lines 32-34), one of skill in the art would recognize the applicability of the claimed methods and constructs to a wide range of plant species. Thus, commonality of operation, function, or effect among the embodiments is disclosed, and restriction to a single species of plant is improper.

Under MPEP 806.04(f), claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species. In the instant case, the methods, plants, and DNA constructs claimed comprise interchangeable elements for common operation, function, or

effect, i.e., to modulate cytokinin expression in plant seeds. Therefore, the claims are not mutually exclusive and their restriction is improper.

For the reasons stated above, Applicants submit that the restriction was improper and should, therefore, be withdrawn or modified.

PROVISIONAL ELECTION OF SPECIES

For purposes of compliance with 37 CFR 1.143, Applicants provisionally elect, with traverse, (1) the isopentenyl transferase gene, *ipt*; and (2) the plant species *Zea mays*.

Claims readable on these provisionally-elected species are: 1-5, 7-11, 13, 14, 17, 18, 20-24, 26, 27, 30, 32-36, 38-39, 42-47, with appropriate renumbering and corrections of dependency to be made. Separate sheets are attached marked "version with markings to show changes made" which reflect the provisional election of species made herein.

No change of inventorship is required due to this election.

Respectfully submitted,

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